UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,796	11/08/1999	STEVEN R. DONOVAN	RIC99060	7148

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WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON, DC   20036

EXAMINER
LOGSDON, JOSEPH B

ART UNIT	PAPER NUMBER
2662	

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Advisory Action	Application No. 09/436,796	Applicant(s) DONOVAN ET AL.
	Examiner Joe Logsdon	Art Unit 2662	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 December 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

<div align="center">PERIOD FOR REPLY [check either a) or b)]</div>

a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

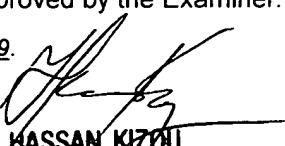   Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: *1-22*.

    Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). <u>9</u>.

10. ☐ Other: _____

HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant argues that the finality of the last Office Action is improper. According to Applicant, a new grounds for rejection under 112, first paragraph was not necessitated by amendment. The new grounds of rejection are only the 112, first paragraph rejections. But prior to the amendments, 112, first paragraph rejections could not have reasonably been made. Consider, for example, claim 1. As noted on page 3 of Applicant's response to the Final Office Action, gateways have been well known in the art. Similarly, proxy and redirect servers; and source and destination user agents have been well known in the art. The specification mentions these entities, and the identity, structure, and function of each of these devices would have been obvious to one of ordinary skill in the art. Therefore, prior to the amendment the 112, first paragraph rejections would have been unreasonable.

After the amendment, however, the situation is different in two respects. First, amended claims 1, 16, and 19 all introduce the limitation that the call setup request, which is sent from the SUA to the SPS, identifies the DUA. This is nowhere taught or suggested in the specification. The call setup request, in traveling from a PSTN to an IP network, must naturally pass through some type of gateway; consistent with the description in the specification, this gateway could be referred to as an ingress gateway. Although the call setup request that is sent from the ingress gateway to the SPS specifies the real IP address of the DUA (page 12, last line; Fig. 3, step a), the specification nowhere teaches or suggests that a call setup request that is sent from the SUA to the SPS specifies the real IP address of the DUA or in any other manner identifies the DUA. As pointed out in the final Office Action, an SIP INVITE message specifies the address of the destination user in a form similar to an e-mail address. In particular, an SIP INVITE message does not normally specify the IP address of a destination user or destination user agent, and an SIP INVITE message does not normally identify the destination user agent. The SUA is not normally aware of the IP address of the DUA--particularly since neither the SUA nor the DUA is part of the IP network. The specification fails to describe the translation, made by the ingress gateway, from the originally specified address to the IP address of the DUA.

Second, amended claims 1 and 16 teach ingress gateways, that the SUA is included in a PSTN or a telephony system, and that the SUA sends the call setup request to the SPS. This combination of three elements is nowhere taught or suggested in the specification. Consider, for example, Figs. 1 and 2. These figures depict two of these features, but fail to depict ingress gateways; the description of these figures, found in the specification, similarly fails to teach ingress gateways. Fig. 3 depicts ingress gateways sending the call setup request to an SPS, but fails to depict the other two features; the description of this figure, found in the specification, similarly fails to teach these two features in combination with the use of the ingress gateways because the specification fails to describe the use of the ingress gateways. In summary, the only part of the specification that teaches ingress gateways also teaches that ingress gateways send the call setup request messages to the SPS--contrary to the description in the claims.

Applicant argues that Schulzrinne and Regnier cannot be combined because the former involves packet switching, but the latter involves circuit switching. But gateways that connect these two network types are well known in the art. Furthermore, Regnier concerns SS7, which is a packet switched network.

New issues that require further consideration and/or search have been raised by Applicant. For example, Applicant asserts, for the first time, that the gateways in Regnier are not the gateways as the term is defined in the specification.